



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Bas Ording

Application No.: 10/090,627

Filed: March 6, 2002

For: AMINATED MENU BAR

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Group Art Unit: 2179

Examiner: MYLINH T TRAN

Confirmation No.: 4921

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant requests review of the final rejection of claims 1-23 set forth in the Office Action dated June 15, 2005. No amendments are being filed with this request.

The request is being filed with a Notice of Appeal.

Background

The claimed subject matter is directed to graphical user interfaces for computers, and more particularly to the menu bar that is displayed for an active application. Quite often, the set of available commands may vary from one application to another. Consequently, the contents of the menu bar will change as the user switches from one application to another. For example, Figure 2a illustrates a menu bar 32 that is associated with a word processing program. If the user switches to a drawing program, as illustrated in Figure 2b, a different menu bar 34 is displayed. The new menu bar simply replaces the previous menu bar. Since the user is typically looking at the content of the application window during the switch from one application to another, and not at the menu bar itself, the change in menu

bars may go unnoticed. As a result, the user may be unaware of the fact that a new set of commands are available.

The invention which is the subject of the present application is designed to present an aesthetically pleasing notification to the user that a change in the menu bar is occurring. One example of the effect provided by the claimed subject matter is illustrated in Figure 5 of the application. As depicted in the sequence of window displays, the previous menu bar 48 appears to rotate up into the border of the window, and the new menu bar then rotates downward in its place. By means of an effect such as this, the user is provided with visual notification of the change in menu bars.

The Rejections

Claims 1-8, 14-17 and 23 stand finally rejected under 35 U.S.C. §103, as being unpatentable over the Koppolu patent (US 5,706,458) in view of the Ubillos patent (US 5,999,173). Claims 9, 10, 18 and 19 stand rejected on the basis of these two patents, and further in view of the Cohen et al patent (US 5,395,712). The issue to be reviewed is whether the final Office Action establishes a prima facie case of obviousness that meets the criteria set forth in M.P.E.P. §2143.

The Koppolu patent was cited as disclosing the updating of a computer display to display a second menu bar in place of a first menu bar. The Office Action acknowledges, however, that the Koppolu patent does not teach "rendering animation graphics to animate the transition between the first and second menu bars such that the difference between the first menu bar and second menu bare [sic] are apparent." To this end, therefore, the rejection relies upon the Ubillos patent as teaching such a feature.

As pointed out in Applicant's response filed September 15, 2005, the Ubillos patent has nothing to do with the transition between menu bars in a graphical user interface. See the response at page 2, first full paragraph, through page 3, first full paragraph. More importantly, there is no teaching in either reference that would motivate a person to apply any of the concepts disclosed in the Ubillos patent to the *menu bar* of a graphical user interface. See the response at page 2, second full paragraph, through page 4, first full paragraph.

M.P.E.P. §2143 sets forth three basic criteria that must be met to establish a *prima facie* case of obviousness. The first of these is that "there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings." This section of the Manual goes on to state that the teaching or suggestion to make the claimed combination "must... be found in the prior art, not in applicant's disclosure," citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 4138 (Federal Circuit 1991). It is respectfully submitted that the final Office Action fails to meet this basic requirement for a *prima facie* case of obviousness.

As purported motivation for combining the references, the final Office Action states "Motivation of combining would have been to present users with visual notification that the menu bar options have changed." (Office Action at page 3, lines 6-7). The Office Action fails to provide any support for this statement. In particular, it does not identify any teaching or suggestion to combine the references that can be found "in the prior art," as required by the standards set forth in the M.P.E.P. The Office Action acknowledges that the Koppolu patent does not contain any teaching of

this objective. Furthermore, it does not identify any disclosure in the Ubillos patent that provides such a motivation.

As pointed out in the arguments presented in Applicant's response filed September 15, 2005, the Ubillos patent does not contain any disclosure relating to menu bars in a graphical user interface, let alone the desirability of providing visual notification that a menu bar has changed. The Office Action principally relies upon the disclosure at column 12, lines 24-36 of the Ubillos patent. This disclosure has nothing to do with menu *bars*, particularly the transition from one bar to another. It is directed to individual icons. These icons are animated to provide the user with feedback on the type of effect that would occur if the user selects a particular one for application to the video clips. Thus, the animations are applied to entirely different objects, for totally different purposes.

The record does not identify any nexus between the textual menus of the Koppolu patent and the video clip editing system of the Ubillos patent that would motivate a person to apply any of the concepts disclosed in the Ubillos patent to the menus of the Koppolu patent. The icons shown in Figure 12 of the Ubillos patent are not related in any way to the menu bar, e.g. 104 of the Koppolu patent. The contention that it would be obvious to combine the disclosures of the patents, therefore, can only be based upon hindsight knowledge of the present application.


For at least the foregoing reason, it is respectfully submitted that the final Office Action fails to establish a *prima facie* case of obviousness, since it does not identify any teaching *in the prior art* that would lead one to combine the Koppolu and Ubillos patents. As such, there is an insufficient record to be presented to the Board

of Patent Appeals and Interferences. Withdrawal of the final Office Action is respectfully submitted to be in order.

Respectfully submitted,

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Date: November 15, 2005

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